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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/957,187	10/24/1997	EKKEHARD BEER	514425-3566	9736

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EXAMINER

KRUER, KEVIN R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 01/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/957,187

Applicant(s)

BEER ET AL

Examiner

Kevin R Kruer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 03 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-14 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-14 and 16-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION***Specification***

The amendment filed December 3, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: On page 12, line 31 of the specification; the specification states that the non-oriented film has a thickness of 80 microns. Applicant is attempting to amend the specification on to read on a film thickness of 30um. However, there is no explicit support for such an amendment in the original disclosure. Furthermore, one of ordinary skill in the art would not have implicitly known that 30um was disclosed. Applicant argues that "80um" was a typographical error. However, there is nothing in the original disclosure that validates Applicant's argument. Thus, the amendment constitutes new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 10-14, and 17-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose et al. (US 5,532,030) in view of (a) Silverman (US 3,786,221) or Sincock (US 3,900,120) and (b) Valyi (US 5,702,665), Hale et al. (US 4,325,797), or Ryder (US 4,285,657) for reasons of record.

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2. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose et al. (US 5,532,030) in view of (a) Silverman (US 3,786,221) or Sincok (US 3,900,120) and (b) Valyi (US 5,702,665), Hale et al. (US 4,325,797), or Ryder (US 4,285,657), as applied to claims 1-14, and 17-20, above, and further in view of Tanaka et al. (US 5,556,920) for reasons of record.

3. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose et al. (US 5,532,030) in view of (a) Silverman (US 3,786,221) or Sincok (US 3,900,120) and (b) Valyi (US 5,702,665), Hale et al. (US 4,325,797), or Ryder (US 4,285,657), as applied to claims 10-14, and 17-20 above, and further in view of Schirmer (US 4,442,147) and US2002/0037393A1 (Strobel et al) for reasons of record.

4. Claim 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose et al. (US 5,532,030) in view of (a) Silverman (US 3,786,221) or Sincok (US 3,900,120) and (b) Valyi (US 5,702,665), Hale et al. (US 4,325,797), or Ryder (US 4,285,657). Hirose discloses a film or sheet made from at least one cycloolefin-based resin selected from the group consisting of (1) an ethylene/cycloolefin random copolymer obtained by polymerizing a cycloolefin (represented by formula I) with ethylene, (2) a cycloolefin homopolymer, or (3) hydrogenated product thereof (abstract). The structure of the cycloolefin component is given in the abstract wherein n may be zero or positive integer, and substituents R_1 - R_{12} may be a radical selected from the group consisting of hydrogen atom, halogen atom, and hydrocarbon groups (abstract). See pages 9+ for specific examples of cycloolefins that are defined by formula I. The multi-

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layer laminate may be subjected to monoaxial or biaxial stretching and has a thickness of 0.5-5mm (page 28, lines 2+).

Hirose does not teach the claimed puncture resistance or the claimed moisture impermeability. However, Silverman teaches that molecular orientation improves thermoplastics' impact resistance (col 1, lines 11+). (NOTE: the test method by which applicant measures puncture resistance is the same test method utilized in the art to measure impact resistance. Therefore, the examiner will utilize "puncture resistance" and "impact resistance" as synonyms in this application). Sincock similarly teaches that molecular orientation of thermoplastic materials is known in the art to improve the material's impact resistance. Furthermore, it is known in the art that molecular orientation of thermoplastic materials improve the material's gas impermeability (see '657, col 1, lines 10-15; '797, col 6, lines 23+); and '665, col 1, lines 10+). Therefore, the examiner takes the position that it would have been obvious to one of ordinary skill in the art to vary the molecular orientation of the film taught by Hirose in order to optimize the film's water vapor permeability and impact resistance. The examiner notes that moistureproofness and mechanical strength are desired by Hirose (see abstract).

Response to Arguments

Applicant's arguments filed December 3, 2002 have been fully considered but they are not persuasive.

Applicant argues that Hirose in view of the secondary references does not disclose, suggest, or motivate one of ordinary skill in the art to molecularly orient the film taught in Hirose at a ratio of 1.1 to 4.0. The examiner respectfully

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disagrees. The secondary references teach that molecular orientation is a result effective variable that will alter a film's moisture permeability and mechanical properties. The courts have held that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation (see MPEP 2144). Thus, the examiner maintains the position that the secondary references would have motivated one of ordinary skill in the art to optimize the stretch ratio of the film taught in Hirose in order to obtain the desired moisture permeability and mechanical properties.

Applicant further argues that the examiner has picked and chose from the teachings of the secondary references, and is only proposing that it is "obvious to try" the proposed modification to Hirose. The examiner respectfully disagrees with applicant's analysis of the rejection. The secondary references teach that molecular orientation results in improved mechanical properties and moisture permeation. Therefore, the secondary references provide clear motivation to one of ordinary skill in the art to make the proposed modification to Hirose. The courts have held that the optimization of a result effective variable is sufficient motivation to establish a prima facie case of obviousness.

Hirose does not disclose a film that possesses the claimed moisture permeation, puncture resistance, and thickness. In the rejection, the examiner acknowledged that Hirose is silent to the film's moisture permeation and puncture resistance. To rectify this deficiency, the examiner relied upon the secondary reference to motivate one of ordinary skill in the art to optimize the moisture permeation and puncture resistance. In response to applicant's arguments

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against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Hirose does teach the claimed film thickness.

Applicant also argues that the claimed invention exhibits unexpected results. Applicant points to the declaration of Dr. Hatke, filed November 1, 2001, to support said claim of unexpected results. The declaration was previously discussed in Paper #25. Applicant's attention is directed to the "Response to Argument" section of that Paper for a full discussion of the declaration.

Thus, Applicant's arguments are not persuasive.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday from 7:00a.m. to 4:00p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is 703-305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

KRK

KRK

Paul Thibodeau
Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700